

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent application of:

Applicant(s): Robert J. Bend
Serial No: 10/564,926
Filing Date: January 17, 2006
Title: CYLINDER LINER IMPROVEMENTS
Examiner: Andrea M. Valenti
Docket No. EQUIP0538WOUS

RESPONSE TO PETITION DECISION DATED NOVEMBER 9, 2007

Mail Stop L&R
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Further and favorable consideration of the above-referenced petition is respectfully requested in view of the following remarks and submissions.

In the event any fee or additional fee is due in connection with the filing of this paper, the Commissioner is authorized to charge those fees to our Deposit Account No. 18-0988 (under the above Docket Number). In the event an extension of time is needed to make the filing of this paper timely and no separate petition is attached, please consider this a petition for the requisite extension and charge the fee to our Deposit Account No. 18-0988 (under the above Docket Number).

REMARKS

The petition was found defective because it did not meet the requirements set forth in 37 C.F.R. 5.25(a)(2), (3)(iii), and (4). Subsection (a)(2) requires the dates on which the material was filed in each country. These dates were included in the original petition for the foreign filing license along with the fee required by subsection (4). Both the petition and showing of payment are attached.

In addition, subsection (3)(iii) requires an explanation of why the material was filed abroad through error and without deceptive intent. The present application was secured by the owner-of-record, Equipment Merchants International, Inc. in an Australian bankruptcy-like proceeding. (Assignment is recorded at Reel 017572 Frame 0518.) The Australian attorneys have been requested to provide a verified statement. But they have refused on the basis of outstanding debt in the name of the original owner of the application at issue. A copy of that letter is attached. The attorney specifically notes that "in light of the history of this matter" he will have to give our request "some consideration."

In view of this refusal, it is respectfully submitted that the previously provided declaration of the sole inventor, Robert J. Bend, be accepted as a showing that the Australian Provisional Patent Application No. 2003903648 and corresponding PCT Patent Application PCT/AU2004/000949 were filed, without the required foreign filing license, through error and without deceptive intent. The inventor and the present owner should not be punished by the non-cooperation of the Australian attorney.

In the alternative, a stay of this petition for a period of six months, is respectfully requested, so that further pleas may be made to the Australian attorney.

There are several pending petitions with a similar error of filing abroad without obtainment of a foreign filing license. As the present applicant and its attorneys were not involved in these errors, the procedural steps already in place are able to prevent this error from occurring again.

Respectfully submitted,
RENNER, OTTO, BOISSELLE & SKLAR, LLP

By /Cynthia S. Murphy/
Cynthia S. Murphy, Reg. No. 33,430

1621 Euclid Avenue
Nineteenth Floor
Cleveland, Ohio 44115
(216) 621-1113

CERTIFICATE OF MAILING, FACSIMILE OR ELECTRONIC TRANSMISSION

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X being transmitted via the USPTO Electronic Filing System.

/Cynthia S. Murphy/
Cynthia S. Murphy

January 2, 2008
Date

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Docket No: EQUIP0538WO

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re **INTERNATIONAL PATENT** application of:

Applicant: ROBERT J. BEND

Application No: PCT/AU2004/000949

For: CYLINDER LINER IMPROVEMENTS

Filing Date: July 15, 2004

PETITION FOR RETROACTIVE FOREIGN FILING LICENSE
37 C.F.R. 5.25

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P.O. Box 1450
Alexandria, VA 22313-1450

Applicant hereby petitions for a retroactive license under 35 U.S.C. 184.

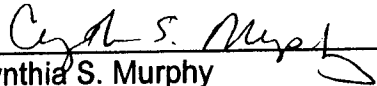
The unlicensed patent application material was contained in a provisional application filed on July 16, 2003 (AU 2003903648) and the above-identified PCT application, claiming priority to this provisional application, was filed on July 15, 2004 with the Australian Patent Office. (A copy of the published PCT application is enclosed).

A verified statement from the inventor/applicant, Robert J. Bend, is attached.

Payment by credit card in the sum of \$130.00 (Form PTO-2038 is attached) for the required fee under 37 C.R.F. 1.17(h) .

Please contact the undersigned if anything further is required for the granting of this petition.

Respectfully submitted,


Cynthia S. Murphy
Renner, Otto, Boisselle & Sklar, LLP
1621 Euclid Avenue, 19th Floor
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Date: August 22, 2005

Claudia Bader
Claudia Bader

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Docket No: EQUIP0538WO

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re **INTERNATIONAL PATENT** application of:

Applicant: ROBERT J. BEND

Application No: PCT/AU2004/000949

For: CYLINDER LINER IMPROVEMENTS

Filing Date: July 15, 2004

PETITION FOR RETROACTIVE FOREIGN FILING LICENSE
AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

Attention Petitions Office
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant hereby authorizes the Commissioner to charge any deficiency in fees connected with the Petition for Retroactive Foreign Filing License in the above-identified application to our Deposit Account No. 18-0988 (under the above Docket Number). Please contact the undersigned with any questions, comments, or concerns.

Respectfully submitted,

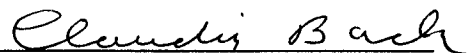

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being sent via facsimile to the Petitions Office facsimile number provided on the Office web site for all facsimile transmissions (571-273-0185) on the date shown below. This transmission includes a total of 1 page.

Claudia Bader
(Type or print name of person faxing paper)

Date: September 7, 2005

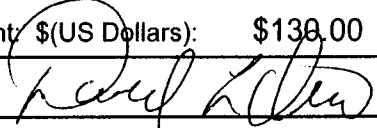

(Signature of person faxing paper)

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Petition for retroactive foreign filing license			
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Application No. PCT/AU04/000949	Application No.	Serial No.	IDON Customer No.
Patent No.	Patent No.	Registration No.	
Attorney Docket No. EQUI.P0538WO		Identify or Describe Mark	

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re **INTERNATIONAL PATENT** application of:

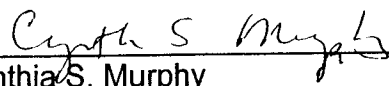
Applicant: ROBERT J. BEND
Application No: PCT/AU2004/000949
For: CYLINDER LINER IMPROVEMENTS
Filing Date: July 15, 2004

**STATUS CHECK - PETITION FOR RETROACTIVE FOREIGN FILING LICENSE
AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

Attention Petitions Office
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant filed a Petition for Retroactive Foreign Filing License on August 22, 2005 (copy attached). At that time a fee of \$130.00 was submitted with payment of credit card (Form PTO-2038). The undersigned received a call from the Petitions Office on September 6, 2005 advising that the fee is \$200.00 and on September 7, 2005 Applicant filed (via facsimile) an Authorization to Charge Deposit Account the additional \$70.00 (copy attached). Please advise the status of our Petition for Retroactive Foreign Filing License. Please contact the undersigned with any questions, comments, or concerns.


Respectfully submitted,


Cynthia S. Murphy
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Telephone (216) 621-1113
Facsimile (216) 621-6165

CERTIFICATE OF MAILING (37 CFR 1.8a)

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Date: October 26, 2005


Claudia Bader

Patent and Trade Mark Attorneys

- AUSTRALIA
- NEW ZEALAND
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COLLISON & CO

1877

2007

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- Website www.collison.com.au

Your Ref:

Please quote our reference

Our Ref: 49820GEN DIA:JO

1 August 2007

Via Facsimile Only 1 Page

Renner, Otto, Boisselle & Sklar LLP
 Attention: Cynthia S Murphy
 1621 Euclid Avenue
 Nineteenth Floor
 Cleveland
 OHIO 44115-2191
 UNITED STATES OF AMERICA

Dear Ms Murphy

APPLICATIONS UNDER PCT NO's.

PCT/AU2003/001426, PCT/AU2004/000172, PCT/AU2004/000275
PCT/AU2004/000588, PCT/AU2004/000949, PCT/AU2004/001065
PCT/AU2004/001066 and PCT/AU2004/001221

Thank you for your facsimile of 24 July, 2007 regarding the above international applications.

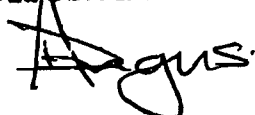
You are correct in that the original Australian applications as well as the subsequent international applications were handled by our firm and also appreciate that they have travelled a long way to land on your desk.

However, you may not be aware that the applicant for each of the applications, Castalloy Manufacturing Pty Ltd, transferred their interest to ION Automotive Ltd some time ago and that ION Automotive Ltd raised a substantial level of debt with our firm and thus since December 2004 we have been exercising our right of lien against these and other files. The amount currently owed to us is approximately AU\$71,000 and we have been met with a wall of silence in this regard.

It is noteworthy that we exercised our right of lien prior to the transfer of any intellectual property and from what I have seen it does not appear as though the new owner of the IP was aware of our lien.

Accordingly, in light of the history of this matter, with due respect, I will have to give your request some consideration.

Yours faithfully
 COLLISON & CO



DR DONALD ANGUS
 (Partner)

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